



DOCKET NO: 241917US2DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JUNICHI KITANO ET AL. : EXAMINER: LAURA ESTELLE
EDWARDS
SERIAL NO: 10/649,780 :
FILED: AUGUST 28, 2003 : GROUP ART UNIT: 1734
FOR: SUBSTRATE PROCESSING :
APPARATUS AND SUBSTRATE
PROCESSING METHOD

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the restriction requirement of October 22, 2004, Applicants elect, with traverse, Group II, corresponding to claims 35-42 and 53-61 drawn to a reaction inhibiting/developing system.

The proper criteria for restriction between distinct inventions are provided in MPEP §803. The two criterion are (1) the inventions must be independent or distinct as claimed and (2) there must be a *serious* burden on the examiner if restriction is not required. Regarding the second criterion, if the search and examination of an entire application can be made without a serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions (MPEP §803 (emphasis ours)).

Although the Office Action has identified separate classifications, making a prima face case of a serious burden, it is respectfully submitted that there is no serious burden in searching and examining the entire application. First, the Office Action has made no

showing that a serious search burden exists. Second, using electronic searching, a search may be made of a large number of, or possibly all, classes and subclasses without any additional effort. Thus it is likely that prior art relevant to Groups I and II may be located at the same time and not require a separate search. Further, as patents and other publications in this art often contain descriptions of both process and the product made using the process, information as to both process and product can be found in the same publication. It is very likely that patents and publications directed to a product will have descriptions of the process for making the product, and vice versa, simplifying and streamlining the search and examination process. It is also likely that prior art relevant to Group III may be found while searching for either of Groups I and II.

It is respectfully submitted that the present application is in condition for examination on the merits of all pending claims, and an early and favorable decision is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Carl E. Schlier
Registration No. 34,426

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

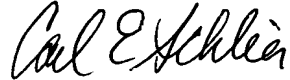
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Reply to Office Action of October 22, 2004

no longer claim inventorship to the present application. The petition fee of \$130.00
accompanies this response.

Acceptance is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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